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09 DEC 2005

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In re Application of	:	DECISION ON
Robin et al	:	
PCT No.: PCT/GB03/01488	:	
Application No: 10/509,781	:	PETITION UNDER
Int. Filing Date: 04 April 2003	:	
Priority Date: 05 April 2002	:	
Attorney's Docket No.: GJE-7020	:	
For: HOLOGRAPHIC SENSOR BASED ON A	:	37 CFR 1.47(a)
VOLUME HOLOGRAM IN A POROUS MEDIUM	:	

This is in response to the "PETITION TO FILE APPLICATION WITHOUT SIGNATURE OF JOINT INVENTOR" filed on 14 November 2005, which is being treated as a petition under 37 CFR 1.47(a).

**BACKGROUND**

On 04 April 2003, petitioner filed international application PCT/GB03/01488, which claimed priority to an earlier application filed 05 April 2002. The thirty-month (30) time period for paying the basic national fee in the United States of America expired at midnight on 05 October 2004.

On 29 September 2004, petitioner filed in the United States Patent & Trademark Office a transmittal letter for entry into the national stage in the U.S. under 35 U.S.C. 371, which was accompanied by, inter alia, the U.S. basic national fee. No executed oath or declaration accompanied the above papers.

On 10 May 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, inter alia, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a), and (b), identifying the application by International application number and international filing date. The notice indicated that all of the items set forth must be submitted within two (2) months from the date of this Notice or by 32 months from the priority date for the application, whichever is later. Failure to properly respond will result in abandonment.

On 14 November 2005, petitioner filed the present petition, a declaration in support of filing on behalf of omitted inventor Satyamoorthy Kabilan accompanied, inter alia, an executed Declaration without the signatures of Satyamoorthy Kabilan.

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

#### **REFUSAL TO JOIN:**

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has satisfied items (1) and (4) under 37 CFR 1.47(a) but not items (2) and (3).

Regarding item (1), petitioner has provided the fee under 37 CFR 1.17(g) because the remaining portion of \$70.00 of the petition of \$200.00 has been charged to the Deposit Account No. 19-0065 as stipulated in the petition.

Regarding item (2), Mr. Saliwanchik's states that applicants have been unsuccessful in obtaining the signature of Kabilan as evidenced by his e-mail communication that he is unwilling to sign a declaration. However, these statements are not sufficient to support a finding that the nonsigning inventor, Kaliban refuses to sign because it is unclear if a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, and that after reviewing the application papers the inventor refused to sign.

In addition, petitioner did not file a statement from Ms. Dobree, who is the person involved in the electronic communications listed above and has first hand knowledge of those facts as required by MPEP Section 409.03(d). Since Mr. Saliwanchik did not participate and does not have first knowledge of the electronic communications with Kabilan, he will need to submit a statement from Ms. Dobree with specific facts on the actions referred to by the emails.

Regarding requirement (3), petitioner has not provided a statement of the last known address of the missing inventor, Satyamoorthy Kaliban.

Regarding requirement (4), petitioner has provided an executed declaration signed by all the inventors on behalf of the nonsigning joint inventor Satyamoorthy Kaliban.

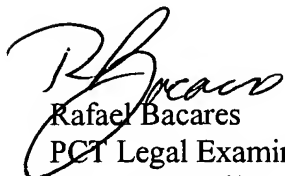
Consequently, the petition does not satisfy all the requirements under 37 CFR 1.47(a).

### **CONCLUSION**

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)."

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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